

## DETAILED ACTION

### *Claim Rejections – 35 USC § 103*

The Examiner stated that claims 21-23, 39, 40, 43-46, 50, 68-71, 75, 198-211, 217 and 218 are rejected under 35 U.S.C. 102(e) as being anticipated by Fano (U.S. Patent 6,317,718) in view of Siegel et al. (U.S. 6,543,209) and Shaked et al. (U.S. 2001/0034718).

The Examiner stated that claims 36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fano (U.S. Patent 6,317,718), Siegel et al. (US 6,543,209) and Shaked et al. (US 2001/0034718), as modified above, in view of Kolls (US Patent 6,389,337).

The Examiner stated that claims 47-49, 212, 213, 215, 216, and 219 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fano, Siegel et al. and Shaked et al., as modified above.

Applicant believes that this was a mistake by the Examiner because only one reference may be used in a 102(e) anticipation rejection. The second half of the wording used in the paragraph set forth by the Examiner as the grounds for the rejection is 35 U.S.C. §103(a). Applicant will respond accordingly.

In regard to claims 21, 68 and 217, as stated in the Office Action dated June 10, 2008, the Examiner states that “But is silent regarding where the data element is a coded designator that is a combination of at least two of the user’s attributes, and where one of the attributes is related to the user’s confidential financial information. Siegal et al. teaches, in column 5, lines 46-50, that it is old and well know in the art of data processing to use codes with multiple attributes to provide desired information with only one code”

Applicant respectfully disagrees as Siegal, column 5, lines 46-50 illustrates a preferably bar coded product package designator. This product package bar code may desirably contain information regarding the actual drug stored within the package as well as the expiration codes, lot codes or any other information which is required. Siegal is *old and well known in the art*. Bar codes have been around for approximately twenty years or more. Applicant’s claims are new and is based on a completely different basis. Applicant’s claims as read as a whole cannot be construed as a bar coded product. Nor was it well known in the art at the time the invention

was made to use *a bar code* as a “*data element is a coded designator that is a combination of at least two of the user’s attributes, and where one of the attributes is related to the user’s confidential financial information*” as taught by Applicant’s claims. Rather the Examiner is distilling the invention down to a gist or a thrust of the invention by trying to substitute a bar code for the complex databases provided for in Applicant’s claims wherein a coded designator is used in a third party data base to provide certain information related to purchases to other parties without revealing the customer’s personal information due to privacy laws. Thus, in one embodiment, the third party data base provides coded processed data but not raw data. *See* specification, page 30. *See also KSR International Co. v. Teleflex, Inc., et al.* 550 U.S. \_\_\_, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007) (“That approach proceeds from a person having ordinary skill in the relevant art and turns on whether the claimed invention “as a whole” would have been obvious at the time in light of the differences between the subject matter sought to be patented and the prior art.”)(Citations omitted).

Moreover, bar codes as used in Tai have been around for over 20 years, logically every database patent written since then would have to be invalidated under the Examiner’s logic. Applicant’s claims do not disclose a barcode; nor does a barcode provide the sophisticated technology used in Applicant’s claims. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR*).

Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art as whole MPEP §2142.02. Distilling the invention down to a gist or to a thrust of the invention disregards the “as a whole” requirement. MPEP §2142.02. *W. L. Gore & Associates, Inc. v Garlock, Inc.*, 721 F 2d 1540, 220 USPQ 303 (Fed Cir. 1983) *cert. denied*, 469 U.S. 851 (1984) (restricting consideration of the claims to 10% per second rate of stretching of unsintered PTFE and disregarding other limitations resulted in treating claims as though they read differently than allowed).

However, purely in the interest of expediting the prosecution of the instant invention, Applicant has amended claims 21, 68 and 217 to include the following limitations:

utilizing the identity of the user to obtain at least a further data element related to the user, wherein the further data element includes data that is received from a third party data base and is a coded designator that is a combination of at least two attributes related to the user, wherein at least one of the two attributes is related to received confidential financial information about the user,

utilizing at least in part the combination of the geographic descriptor of the user, and the at least further data element to select among multiple items available for that geographic descriptor the at least one offer for the item in real time with the primary transaction, ~~and~~ the at least further data element including offers previously declined by the user, and

Support for these limitations may be found at least on pages 30, 31, 38 and 39 of the instant application. Applicant has reviewed the references in full, as discussed above, and the limitations as set forth above are clearly absent from the references no matter how they are construed.

As such, Applicant respectfully believes that the amended independent claims, as well as the claims that depend on them, are in condition for allowance and respectfully request they be passed to allowance.

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Respectfully submitted,

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